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10/643,730	08/18/2003	Chandrasekhar Narayanaswami	YOR920030211US1	4685
23334 7590 07/10/2008 FLETT GIBBONS GUTMAN BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487				
EXAMINER ARAQUE JR, GERARDO				
ART UNIT 3689		PAPER NUMBER		
NOTIFICATION DATE 07/10/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptoboca@fggbb.com

Office Action Summary**Application No.**

10/643,730

Applicant(s)NARAYANASWAMI,
CHANDRASEKHAR**Examiner**

Gerardo Araque Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. **Claim 20** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The Examiner asserts that **claim 15** has already established that the transmitter will send the refund to the user.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claim 15** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant states on **Page 18 of 19 of Remarks** that support for, "...wherein the transmitter is further for sending a portion of

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the refund directly to the user and keeping a remaining portion of the refund as a fee associated with the user..." can be found in paragraph [0050] of the U.S. Pre-Grant Publication No. 2005/0044001 of the present application. However, the Examiner asserts that no support was found at this citation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1 – 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McClung, III (US Patent 7,107,225 B1)** in view of **Thakur et al. (US PGPub 2002/0194069 A1)**.

7. In regards to **claims 1, 8, and 15**, **McClung** discloses a method for offering purchase price protection for a product and/or service, the method comprising the steps of:

receiving, by a first web site, information directly from a user, the information being entered by the user at the first web site via a user interface at the first website, wherein the information (**discussed below**) is associated with a product and/or service that was purchased by the user, wherein the information includes the purchase price of the product and/or service and wherein the vendor offers purchase price protection for the product and/or service, wherein the user also enters a type of price protection offered by the second website, and wherein the user submits the information to the first

web site by selecting a button on the user interface (**discussed below**) (Col. 2 Lines 14 – 27, 53 – 56; Col. 4 Lines 8 – 30; Col. 5 Lines 41 – 54);

initiating, by the first web site, the purchase price protection offered by the second website as indicated by the user for the product and/or service in response to the user selecting the button on the user interface (**Col. 2 Lines 14 – 27**);

determining, a price for the product and/or service (**Column 2 19 – 23**);

determining whether the user is due a purchase price protection refund based on the price determined at the second web site (**Column 1 Lines 39 – 45; Column 3 lines 17 – 22**);

(Claim 8) the user also entering a notification type selection indicating how the user is to be notified of a refund from the purchase price protection (Col. 2 Lines 60 – 65 wherein the user can log on to the site to receive the notification or wait by having the host system contact the user using the providing contact information, if any information was ever provided. That is to say, the system's default is to notify them through the web site unless another method has been provided); and

sending an indication r to the user (**Claim 8) based on the notification type selection entered by the use** indicating that the purchase price protection refund is due (**Column 1 Lines 58 – 60; Column 3 Lines 17 – 22**);

(Claim 15) wherein the transmitter is further for sending a portion of the refund directly to the user and keeping a remaining portion of the refund as a fee associated with the user (Col. 1 Lines 47 – 52, 64 – 67; wherein it would have been obvious to one of ordinary skill in the art that the host system is in communication with the

vendors and when a refund becomes available the host system will handle the making available of the refund to the customer and credit the amount to the customer's account and wherein it is common sense that business have an associated fee for carrying out said service).

McClung further discloses, in certain embodiments, an improvement for a method for generating vendor information including contacting a host system by a consumer identifying at least one vendor doing business in a pertinent geographic area and retrieving from the host system information related to the vendor. The improvement including providing a method to guarantee to the consumer a better price or a best price on items or services purchased from the vendor for a predetermined time period following a transaction.

However, **McClung** fails to explicitly disclose whether a consumer performed the purchase at the host system or at the vendor's web site. In spite of this, McClung fully incorporates the patent application, "Business System" by Thakur et al., wherein Thakur discloses the communication system between a host system, consumer, and vendor.

Thakur discloses that a consumer makes an initial inquiry to the host system and fills out a host system questionnaire. The host system can further keep a record of the consumer's transactions with each vendor in its database including payments, discounts refunds, and accounting transactions. As can be seen in Fig. 1, the consumer can perform transactions directly with the vendor and provide any necessary information to complete the host system questionnaire. The host system is also in communication with the vendor and the consumer, as well. As a result, it would have been obvious for

a consumer to purchase a product from a vendor, provide the vendor information to the host system, having the host system search for the vendor within the host system database, and have the host system be in communication with the vendor in order to monitor any transactions made between the vendor and the consumer (**See Fig. 1, Page 5 – 6 ¶ 57, 61 – 64; Page 7 ¶ 74**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **McClung** in view of the teachings of **Thakur** to provide a system where a consumer can perform a transaction with a vendor, provide the vendor information to a host system, and have the host system be in communication with the vendor in order to monitor any transactions made between the vendor and consumer in the event that a refund or discount is applicable.

8. In regards to **claims 2, 9, and 16**, **McClung** discloses wherein the user interface at the first web site includes a web page having a list of text fields and identifiers for the user to enter at least one of the following information associated with a product and/or service that was purchased by the user from the second web site, the user thereby providing information directly to the first web site (**Column 4 Lines 8 – 30**):

- a name of the product and/or service;
- a description of the product or service;
- an identifier of the product and/or service;
- a name, address and telephone number of the second web site;
- a date the product and/or service was purchased by the user; and
- a price the user paid for the product and/or service.

9. In regards to **claims 3, 10, and 17**, the **combination of McClung and Thakur** discloses wherein the first determining step comprises the steps of:

visiting the second web site (**McClung Col. 4 Lines 8 – 30; Col. 5 Lines 41 – 54; Thakur Fig. 1, Page 5 – 6 ¶ 57, 61 – 64; Page 7 ¶ 74**);

selecting the product and/or service on the second web site (**McClung Column 4 Lines 8 – 30; Col. 5 Lines 41 – 54; Thakur Fig. 1, Page 5 – 6 ¶ 57, 61 – 64; Page 7 ¶ 74**); and

reading from the second web site a price associated with the product and/or service (**McClung Column 2 Lines 19 – 35; Col. 4 Lines 8 – 30; Col. 5 Lines 41 – 54; Thakur Fig. 1, Page 5 – 6 ¶ 57, 61 – 64; Page 7 ¶ 74**).

10. In regards to **claims 4, 11, and 18**, **McClung** discloses wherein the second determining step comprises the steps of:

determining a time period of the purchase price protection offered by the second web site for the product and/or service, the current time, the purchase price of the product and/or service, and the current price of the product and/or service at the second web site (**Column 4 Lines 8 – 30**); and

if the current time is within the time period of the purchase price protection and the purchase price of the product and/or service is greater than the price at the second web site, then determining that the user is due a purchase price protection refund (**Column 1 Lines 39 – 45**); and

otherwise, determining that the user is not due a purchase price protection refund (**obviously included**).

11. In regards to **claims 5, 12, and 19**, **McClung** discloses further comprising the step of:

the first web site providing directly to the user with information necessary for redeeming the refund that is due from the purchase price protection offered by the second web site, such that the user may redeem the refund directly from the second web site **(Columns 7 – 8 Lines 47 – 20)**.

12. In regards to **claims 6, 13, and 20**, **McClung** discloses further comprising the steps of:

the first web site sending directly to the user a refund corresponding to the refund due from the purchase price protection offered by the second web site **(Claim 6)**; and

the first web site redeeming from the second web site, on behalf of the user, the refund the user is due from the purchase price protection offered by the second web site **(Col. 1 Lines 47 – 52, 64 – 67; wherein it would have been obvious to one of ordinary skill in the art that the host system is in communication with the vendors and when a refund becomes available the host system will handle the making available of the refund to the customer and credit the amount to the customer's account)**.

13. In regards to **claims 7 and 14**, **McClung** discloses wherein the first web site and the second web site are separate e-commerce web sites **(Column 1 Lines 53 – 60; Column 2 Lines 14 – 29)**.

Response to Arguments

14. Applicant's arguments filed 2/26/08 have been fully considered but they are not persuasive.

Rejection under 35 USC 103

15. Applicant argues that the **combination of McClung and Thakur** fails to teach or disclose:

"...receiving, by a first web site, information directly from a user, the information being entered by the user at the first web site via a user interface at the first website, wherein the information is associated with a product and/or service that was purchased by the user from a second web site different from the first web site, wherein the information includes the purchase price protection for the product and/or service, and wherein the user submits the information to the first web site by selecting a button on the user interface;..."

In response to applicant's argument that "The system of Thakur merely teaches a system for providing future discounts such as coupons to a consumer (**Page 12 of 19 of Remarks**)" and that "Nowhere does Thakur teach or suggest that a consumer enters any information regarding a purchase," the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

16. Further still, the Examiner has already stated that **Thakur** was used to teach the system used in the method of **McClung**. That is to say, **McClung** discloses using the system of **Thakur** to allow a user to use the host system after a purchase has been made (**Col. 1 Lines 39 – 45, 60 – 63; Col. 4 – 5 Lines 67 – 8; Figure 1**). **McClung** discloses that it is obvious that the consumer logs into the host system after a purchase is made from a vendor, which would obviously include purchases made from another web site, and provides the product information to the host system. All of which would require a button in order to allow the user to submit the inputted information. The host system then monitors the price of the purchased item with the prices of other vendors and would then notify the consumer if a refund is available.

Although, the applicant argues that it appears that **Thakur** uses the system prior to a purchase or that the system is used for discounts or that it does not mention price protection the Examiner asserts that **Thakur** was not used to teach these limitations. As discussed above, **McClung** teaches all of these limitations, but fails to teach how the different components of the system interact with each other. The fact that **Thakur** may teach that the communication is carried out prior to a purchase does not change the fact that **McClung** teaches that it would have been obvious to one having ordinary skill in the art that the communication can also be carried out after a purchase has been made. That is to say, the Examiner provided **Thakur** as an additional teaching in order to show that the system used by **McClung**, which is the system found in **Thakur**, would have obviously allowed one having ordinary skill in the art that a consumer can perform a transaction with a vendor, provide the vendor information to a host system, and have

the host system be in communication with the vendor in order to monitor any transactions made between the vendor and consumer in the event that a refund or discount is applicable.

Moreover, the above claims recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. In addition, neither applicant's Specification nor applicant's arguments present any evidence that modifying **McClung** with the selected elements of **Thakur** was uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the combination of **McClung** with the teachings of **Thakur** to provide a system where a consumer can perform a transaction with a vendor, provide the vendor information to a host system, and have the host system be in communication with the vendor in order to monitor any transactions made between the vendor and consumer in the event that a refund or discount is applicable. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

17. Regarding the applicant's argument that the **combination of McClung and Thakur** fails to teach or suggest a consumer inputting the information because, as stated by the applicant, "...the host system as taught by Thakur to which McClung is using uses a magnetic card with consumer information to obtain consumer identifying

information and sales information." The Examiner disagrees. The Examiner asserts that the act of the consumer using the magnetic card reads on the limitation of a consumer inputting information because it still requires the user to use the card in order to provide the information.

18. Regarding applicant's argument on **Page 15 of 19 of Remarks** where the applicant states, "The Applicant respectfully suggests that if McClung 'obviously included for the host system to have a listing text fields and identifiers in order for the user to properly input the necessary information into the host system' such as information associated with a product and/or service that was purchased by the user from a second web site then the Examiner should be able to point out where in McClung this is taught. However, nowhere does McClung teach this."

The Examiner disagrees that **McClung** requires for such a statement to be present in the disclosure of **McClung**. **35 U.S.C. § 103(a)** clearly states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Therefore, the Examiner asserts that one having ordinary skill in the art would have found it obvious from the teachings **McClung** as well as what is commonly known in the art that an online computer system having a web site requiring information to be inputted for comparing purposes, for example, would obviously have had text fields and identifiers in order for the information to be properly compared. That is to say, it would have been obvious that if a consumer wanted to make sure that the Motorola cell phone

that was purchased for \$50.00 would required for the user to input the terms "Motorola" and "\$50.00" into some type of field in order for the computer system to properly store and monitor the correct product and price.

In addition, neither applicant's Specification nor applicant's arguments present any evidence that modifying **McClung** uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify **McClung** to obviously include for the host system to have a listing text fields and identifiers in order for the user to properly input the necessary information into the host system. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

19. Regarding applicant's argument that, "McClung merely teaches that a consumer contacts a host system" is incorrect. **McClung** clearly discloses that the consumer is using the host system in order to provide the appropriate information to carry out the comparison (see at least Col. 1 Lines 60 – 64).

20. The applicant argues that **Thakur** does not teach, "a user entering information associated with a product and/or service that was purchased by the user from a second web" on **Page 16 of 19 of Remarks**. However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further still, the Examiner has already addressed the combination above.

21. Applicant's arguments with respect to the **amended portions of claims 1, 8 and 15** have been considered but are moot since they were not previously considered.

Dependent Claims

22. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over **McClung** in view of **Thakur**.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
7/3/08

/Janice A. Mooneyham/
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